

# REMARKS

The Office Action dated March 5, 2008 has been received and carefully studied.

The Examiner provisionally rejects claims 1-7 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of co-pending Application Serial No. 10/593,920. The Examiner states that it is well known that pesticides are often useful for controlling both insects and acarians such as mites and ticks.

In order to expedite allowance, submitted herewith is a terminal disclaimer to overcome the rejection.

The Examiner rejects claims 1-7 under 35 U.S.C. §102(b) as being anticipated by Tanabe et al., JP200316810. The Examiner states that Tanabe discloses the instant N-substituted indoles of formula (I) as well as their use as a flea controlling agent, and a shampoo and liquid drops comprising the flea control agent.

The rejection is respectfully traversed.

Tanabe et al. is not a proper reference to this case. The present case is the National Phase of PCT/JP2004/005768, and the inventors are the same as those in Tanabe et al. Accordingly, 35 U.S.C. §102(a) does not apply. In addition, since the instant PCT application was filed within a year of the publication date of Tanabe et al., 35 U.S.C. §102(b) also does not apply. Withdrawal of the rejection is respectfully requested.

The Examiner also rejects claims 1-7 under 35 U.S.C. §102(b) as being anticipated by Hotta et al., JP6092935. The Examiner

states that Hotta et al. disclose the instant N-substituted indoles of formula (I) and their use in an insecticidal composition.

By the accompanying amendment, claim 1 has been amended to recite a flea control agent comprising a flea-killing effective amount of an N-substituted indole derivative.

Hotta et al. describe the use of an N-substituted indole derivative, which is the same as the derivative of the general formula (I) of the instant claims, in the control of noxious organisms in paddy fields, agricultural fields, and the like. However, in this context Hotta et al. specifically describe only that the indole derivatives were effective in controlling nilaparvata lunge-ns belonging to Hemiptera and plutella xylostella belonging to Lepidoptera. Thus, these insects such as nilaparvata lunge-ns and plutella xylostella are noxious organisms in agricultural fields, and are totally different from fleas, which are insect pests on companion animals such as dogs and cats.

Hotta et al. also describe at paragraph [0001] that the indole derivative can be used to protect humans or animals from a parasitic obstacle or hindrance, and at paragraph [0029] that the insect pests, to which the indole derivative can be applied, include Pulex irritans, Xenopsylla cheopis and Ctenocephalides canis. However, Hotta et al. fail to describe fleas as the insect pests.

On the other hand, Examples 4 and 5 in the present specification clearly demonstrate the controlling effects of the indole derivative on cat flea. These effects are neither taught nor suggested by Hotta et al. In addition, as described in the present specification at page 2, line 26 to page 3, line 6, the present invention is based on the new finding that the N-substituted indole derivative has low toxicity to animals. Indeed, Test Examples 1 and 2 of the present specification demonstrate that the N-substituted indole derivative has low toxicity to mouse and cat.

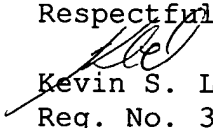
Accordingly, it cannot be predicted from the teachings of Hotta et al. that the indole derivative can control fleas, and the flea control agent of the present invention is therefore believed to be patentable over the cited reference.

With particular reference to claim 6 and 7, Hotta et al. provide no disclosure or suggestion of a shampoo or rinse for controlling fleas, or a percutaneous preparation comprising liquid drops for controlling fleas.

Claims 6 and 7 have been amended, and claims 8 and 9 newly added, to correct improper multiple dependencies.

Reconsideration and allowance are respectfully requested in view of the foregoing.

Respectfully submitted,

  
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